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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/210,539	12/14/1998	AKIRA ISHIBASHI		5289

7590

08/02/2002

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 08/02/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/210,539	Applicant(s) ISHIBASHI ET AL.	
	Examiner Dr. Kelechi C. Egwim	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Specification*

1. The amendment filed 4/46/02 is still objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The original disclosure recited "Bionolle" #1020 as being a **talc-containing (30%) grade of the aliphatic polyester** type biodegradable resin made by Showa Highpolymer Co., Ltd. Applicant amended the specification (in Paper #15) to recite that the 30% talc is no longer contained in this grade of aliphatic polyester resin, but "**added**" to the grade of the aliphatic polyester type biodegradable resin in preparing the raw material according to the present invention. This is inconsistent with the original disclosure and the adding of 30% talc to "Bionolle" #1020 in order to obtain the raw materials is still not supported by the original disclosure

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 102/103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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3. Claims 1, 2, 5, 6, 8 and 10-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., for reasons cited in previous Office actions.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., each independently as applied to claims 1, 2, 5, 6, 8 and 10-12 above, and further in view of Yamada et al., for reasons cited in previous Office actions.

#### ***Response to Arguments***

5. Applicant's arguments filed 6/14/02 have been fully considered but they are not persuasive.

6. Regarding the new matter in the specification, applicant has not provided evidence to prove that Boinelle #1020, as originally disclosed, is not a talc-containing polymer as purchased. Applicant contends that the original disclosure was due to a translational error. However, since the subject matter is of such a substantial nature as to potentially distinguish one of the cited references from the present claims, substantial evidence is required to demonstrate that applicant's Boinelle #1020, as originally disclosed, is not a talc containing polymer. The Examiner has yet to find such evidence.

It is still asserted that Applicant makes it clear in the original specifications that "Bionelle #1020", the grade of Bionelle used in the present invention comprises 30% talc. In page 36, lines 17-23 and col. 37, lines 3-7 of the present specifications,

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Applicant explicitly **defines** Bionelle 1020 as "commercially available" "**talc-containing (30%) grade of the aliphatic polyester type biodegradable resin** made by Showa Highpolymer Co., Ltd and **sold under the trademark designation of 'Bionelle' #1020**". As such, the prior art composition. is essentially the same as the claimed composition.

7. Regarding Tsai et al., in response to Applicant's Declaration under 37 C.F.R. § 1.131, while the declaration stated that invention reports (dated 9/17/97 and 10/31/97) are attached to the Declaration, no such reports were found in the submitted papers.

Further, based on the description of the invention reports in the Declaration, it does not appear that any single one of the invention reports includes the combination of **each and very limitation** in independent claims 1 or 12. Thus, the Declaration is not persuasive.

8. Regarding applicant's arguments that Obuchi et al. does not disclose or suggest a fastening component made from the biodegradable resins, in col. 9, line 32, Obuchi et al. teach that tying materials are among the articles that may be molded from the resin. A tying material is used for fastening.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3599 for regular communications and 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



KCE  
July 31, 2002



DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700